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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,775	03/07/2002	Mohamend El-Sherbeini		9605

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MERCK AND CO INC
P O BOX 2000
RAHWAY, NJ 070650907

EXAMINER

DEVI, SARVAMANGALA J N

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 08/29/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/070,775

Applicant(s)
El-Sherbeini et al.

Examiner
S. Devi, Ph.D.

Art Unit
1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 7, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-17 ~~is~~ are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-11 and 15-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Lack of Unity of Invention(s)

- 1) Claims 12-14 have been canceled.
Claims 1, 8, 9 and 15 have been amended.
Claims 1-11 and 15-17 are under prosecution.
- 2) **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your election responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.
- 3) The instant inventions lack unity under PCT Rule 13.1 and 13.2:
 - I. Claims 1-6, drawn to a polynucleotide of SEQ ID NO: 1, a complement thereto, or a polynucleotide that hybridizes with the polynucleotide or its complement and a host cell comprising the same.
 - II. Claim 7, drawn to a method for producing a MurE protein of *P. aeruginosa* by culturing a host cell.
 - III. Claim 8, drawn to a polypeptide of SEQ ID NO: 2.
 - IV. Claims 9-11, drawn to a method for identifying a compound that inhibits MurE polypeptide of *P. aeruginosa* by providing a host cell comprising a polynucleotide.
 - V. Claims 15-17, drawn to a method for identifying a compound that inhibits MurE polypeptide of *P. aeruginosa* by providing a polypeptide of SEQ ID NO: 2.
- 4) Inventions I-V lack unity of invention due to the absence of a special technical feature. The special technical feature in the instant application is a polynucleotide that is complementary to, hybridizes under stringent conditions with SEQ ID NO: 1. Invention II is drawn to a method for producing a MurE protein of *P. aeruginosa* by culturing a host cell comprising the polynucleotide. Invention III is drawn to polypeptide of SEQ ID NO: 2. Inventions IV and V are drawn to two different identification methods which do not share a significant step and/or a reagent. Although the

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
product of the invention and the first method of using the product is a permitted combination under PCT Rule 13.2, in the instant case, the special technical feature is already disclosed in the art, for instance, by Liao *et al.* (*Antimicrob. Agent Chemother.* 39: 1871-1874, 1995) who disclose a 25 base-long polynucleotide that would hybridize with the polynucleotide of SEQ ID NO: 1. Therefore, the special technical feature is not a unifying feature. Since the special technical feature is already taught by the prior art, it does not define over the prior art. Therefore, technically, the absence of a special technical feature would permit the separation of the method of using or making the product from the product itself.

5) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. A telephone message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

August, 2003


S. DEVI, PH.D.
PRIMARY EXAMINER